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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/724,599 | 12/02/2003 | Stephen Bailey | 117873 | 2608 |
| 25944 | 7590 | 05/02/2006 | | |
| OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320 | | | EXAMINER EVANS, GEOFFREY S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1725 | |
| DATE MAILED: 05/02/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,599

Applicant(s)

BAILEY ET AL.

Examiner

Geoffrey S. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6 is/are rejected.
- 7) ☒ Claim(s) 3, 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in U.S. Patent No. 4,393,292 in view of Briffod in U.S. Patent No. 4,134,807. Inoue discloses method and apparatus for machining a passage through a workpiece (see column 1, lines 18-19 "through-opening") using a hollow electro discharge machining electrode and a corresponding flushing agent supplied via the hollow electrode (see column 4, lines 58-60) wherein a discrete backing member (worktable, element 10; see column 4, lines 67-68 and figure 1) is positioned abutting a face of the workpiece. Briffod teaches a backing member (worktable including slide element 13)

that abuts the entire breakthrough region. It would have been obvious to adapt Inoue in view of Briffod to provide this to support the workpiece.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in U.S. Patent No. 4,393,292 in view of Briffod in U.S. Patent No. 4,134,807 as applied to claim 1 above, and further in view of Tanaka in U.S. Patent No. 5,004,530. Presumably since Inoue does not disclose fluid passing between the workpiece and the table, Inoue (292) has a liquid tight seal between the workpiece and the table (backing member).

However Tanaka teaches that liquid tight seals between elements of an electro discharge machining apparatus are known (see column 2, lines 39-42). It would have been obvious to adapt Inoue in view of Briffod and Tanaka to provide a liquid tight seal between the workpiece and the table (backing member) to prevent short circuits due to lack of liquid in the machining gap.

5. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briffod (807) in view of Inoue (292). Briffod has an apparatus for performing discharge machining with the slide (element 13) of a table abutting a face of the workpiece. Inoue teaches machining a passageway through a workpiece supported by a flat worktable (see column 1, lines 18-19 and figure 1). It would have been obvious to adapt Briffod in view of Inoue to provide this to electro discharge machine a passage through the workpiece.

6. Applicant's arguments filed 16 February 2006 have been fully considered but they are not persuasive. Regarding Applicant's comments about Inoue (292) on page 5 of the Remarks, since elements 10 and 11 are flush with each other there is no need

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for a more specific figure showing their interface in greater detail. Regarding Applicant's comments about Briffod (807) on pages 5 and 6 of the Remarks, The slide (element 13) clearly backs up the workpiece through the entire breakthrough region.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

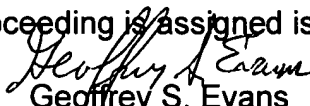
8. Claims 3,7, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on (571)-272-1292. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

GSE


Geoffrey S. Evans
Primary Examiner
Group 1700